1   **REMARKS**

2   The Applicants respectfully request consideration and allowance of claims 43 through 59

3   in view of the above amendments and the following arguments.

4

5   I.   <u>AMENDMENTS TO THE CLAIMS</u>

6   This case was originally filed with claims 1 through 22. Claims 1 through 22 were

7   canceled and claims 23 through 42 were added by the amendment accompanying the Request for

8   Continued Examination filed December 1, 2004. Claims 23 through 42 are canceled above and

9   new claims 43 through 59 are added. Each of the new independent claims includes the limitation

10   that the prioritized data set includes a number of entries therein with each respective entry

11   ordered with respect to each other entry according to the prioritization scheme and with data for

12   each entry also ordered according to the prioritization scheme. Support for this limitation is

13   found at several locations in the disclosure as filed, and particularly in the discussion beginning

14   at line 10, page 28 of the original application through line 2, page 29.

15

16   II.   <u>AMENDMENTS TO THE SPECIFICATION</u>

17   The specification has been amended to correct typographical errors.

18

19   III.   <u>THE CLAIMS ARE NOT DIRECTED TO NON-STATUTORY SUBJECT MATTER</u>

20   The Examiner rejected claims 23 through 29 and 37 through 42 under 35 U.S.C. §101 for

21   being directed to non-statutory subject matter. Specifically, the outstanding Office Action

22   indicates that the language of these claims is directed to an abstract idea that is not tied to a

1   technological art, environment, or machine which would result in a practical application

2   producing a concrete, useful, and tangible result. The Examiner cited *Ex parte Bowman* (61

3   USPQ2d 1669, 1671) in support of this rejection.

4   It is noted that the claims rejected under Section 101 have been cancelled above and

5   replaced with new claims. Although the new claims include numerous differences with respect

6   to the claims previously rejected under Section 101, the general subject matter of the claims

7   remains the same. Specifically, new claims 43 through 48 are directed to methods similar to

8   claims 23 through 29, and new claims 55 through 59 are directed to systems similar to claims 37

9   through 42. The Section 101 rejections in the currently outstanding Office Action are addressed

10   here in light of the similarities between cancelled claims and new claims 43 through 48 and 55

11   through 59.

12   In *Bowman*, the claims were rejected under 35 U.S.C. §101 because no form of

13   technology was disclosed or claimed in the application. The claimed invention in *Bowman* was

14   not tied to any technological art or environment. In contrast to the fact situation in *Bowman*, the

15   disclosure of the present application includes numerous specific references to processing devices,

16   program code, and physical devices through which the claimed invention may be implemented.

17   The methods set out in claims 43 through 48 are very clearly tied to the technologies and

18   environments described in the disclosure portion of the application. Furthermore, claims 55

19   through 59 are specifically directed to systems for prioritizing data and require specific physical

20   components for providing the desired prioritization. For these reasons the Applicants submit that

21   the present claims are very clearly directed to statutory subject matter and are not objectionable

22   under 35 U.S.C. §101.

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1   IV.   <u>THE CLAIMS ARE NOT OBVIOUS IN VIEW OF THE CITED REFERENCES</u>

2   The Examiner rejected claims 23 through 42 under 35 U.S.C. §103(a) as being

3   unpatentable over U.S. Patent No. 6,212,529 to Boothby et al. ("Boothby" or the "Boothby

4   patent") in view of U.S. Patent No. 6,295,541 to Bodnar et al. ("Bodnar" or the "Bodnar patent").

5   The Applicants respectfully submit that the new claims are not obvious over Boothby in view of

6   Bodnar because the proposed combination of references does not teach or suggest each element

7   required in the respective claims.

8

9   <u>Claims 43 through 48</u>

10   Claim 43 is directed to a method for prioritizing data for use in synchronizing data at a

11   client device and requires the following elements:

12   (a)   receiving a synchronization session request;
13   (b)   selecting a prioritization scheme associated with a user;
14   (c)   retrieving scheme effecting data based on the prioritization scheme; and
15   (d)   producing a prioritized data set based on the prioritization scheme and the scheme
16   **effecting data, the prioritized data set having a number of entries therein with**
17   **each respective entry ordered with respect to each other entry according to**
18   **the prioritization scheme and with data for each entry also ordered**
19   **according to the prioritization scheme.** (Emphasis added)

20   The Boothby patent does not teach or suggest the prioritization of data as required by

21   element (d) claim 43. That is, the filtering of records according to Boothby does not order the

22   records according to the prioritization scheme. Also, the filtering of records as disclosed in

23   Boothby does not order the data for each record also according to the prioritization scheme.

24   Rather, the Boothby patent merely applies a filter which results in some records in a source data

25   set being flagged as passing the filter and the remainder of the records being flagged as not

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1 passing the filter. This flagging of certain records does not represent a prioritized data set, that

2 is, a preferentially ranked or ordered data set, as required by claim 43. Furthermore, the flagging

3 of records based on filter criteria as taught by Boothby, has no effect on data included for the

4 various records. That is, nothing in the Boothby patent suggests preferentially ordering the data

5 for the various records.

6 The Bodnar patent does not make up for these deficiencies in Boothby. Bodnar discloses

7 synchronizing data between a number of different databases. In particular, from col. 40, line 13

8 through col. 41, line 31 Bodnar teaches that the records in each client database are linked to a

9 particular record in the synchronizing engine's database in accordance with a mapping table. As

10 described beginning at col. 42, line 31, each time a synchronization takes place between

11 databases, this mapping table may be used to identify the files that need to be updated, added, or

12 deleted. The synchronizing engine then determines any changes that have been made to the

13 records to be synchronized, determines a set of actions to take for each record, and then

14 synchronizes the records. There is nothing in the Bodnar patent that teaches or suggests selecting

15 a prioritization scheme associated with a user as required by element (b) of claim 43, retrieving

16 scheme effecting data based on the prioritization scheme as required by element (c) of claim 43,

17 and producing a prioritized data set as required by element (d) of claim 43.

18 Because the Boothby and Bodnar patents, either considered alone or in combination, do

19 not teach or suggest the prioritization required by element (d) of claim 43, claim 43 cannot be

20 obvious in view of the references. The Applicants therefore respectfully submit that claim 43 is

21 in condition for allowance together with its respective dependent claims, claims 44 through 48.

22

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1   Claims 49-54 and 55-59

2   Independent claim 49 is directed to a program product requiring limitations similar to

3   those in claim 43. In particular, claim 49 requires prioritization program code executable for

4   producing a prioritized data set based on a selected prioritization scheme and scheme effecting

5   data, "the prioritized data set having a number of entries therein with each respective entry

6   ordered with respect to each other entry according to the prioritization scheme and with

7   data for each entry also ordered according to the prioritization scheme." Therefore, the

8   above arguments and comments regarding claim 43 apply with equal force to claim 49 and its

9   dependent claims. Because the proposed combination of Boothby and Bodnar does not teach or

10   suggest any element for performing the prioritizing specifically required of the prioritization

11   program code in claim 49, claim 49 and its dependent claims, claims 50 through 54 are not

12   obvious in view of the proposed combination of Boothby and Bodnar and are entitled to

13   allowance.

14   New independent claim 55 is directed to a system for providing a prioritized data set and

15   also includes limitations as to the prioritization similar to those set out in claim 43. In particular,

16   claim 55 requires a sync engine component that, among other things, produces a prioritized data

17   set based on a selected prioritization scheme and scheme effecting data, where the prioritized

18   data set has "a number of entries therein with each respective entry ordered with respect to each

19   other entry according to the prioritization scheme and with data for each entry also ordered

20   according to the prioritization scheme." Therefore, the above arguments and comments regarding

21   claim 43 also apply with equal force to claim 55 and its dependent claims. Because the proposed

22   combination of Boothby and Bodnar does not teach or suggest any element for performing the

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1   prioritizing function specifically required in claim 55, claim 55 and its dependent claims, claims

2   56 through 59 are not obvious in view of the proposed combination of Boothby and Bodnar and

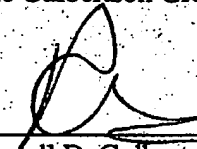3   are entitled to allowance.

4

5   V.   CONCLUSION

6   For all of the above reasons, the Applicants respectfully request consideration and

7   allowance of claims 43 through 59. If the Examiner should feel that any issue remains as to the

8   allowability of these claims, or that a further conference might expedite allowance of the claims,

9   she is asked to telephone the Applicants' attorney, Russell D. Culbertson, at the number listed

10   below.

11

12   Respectfully submitted

13   The Culbertson Group, P.C.

14

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26   I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark

27   Office, (Facsimile No. 703-872-9306) on April __, 2005.

28

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